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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 09/960,625 | 09/20/2001 | Horst Berneth | Mo-6696 LeA 35,619 | 8241 |
| 34947 | 7590 | 12/21/2004 | EXAMINER | |
| LANXESS CORPORATION PATENT DEPARTMENT/ BLDG 14 100 BAYER ROAD PITTSBURGH, PA 15205-9741 | | | ANGEBRANDT, MARTIN J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1756 | |

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------|---------------------------------|--------------------------------|--|
| Advisory Action | Application N . 09/960,625 | Applicant(s) BERNETH ET AL. | |
| | Examiner Martin J Angebrannt | Art Unit 1756 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires eight months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 07 December 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-14.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Martin J Angebrannt
Primary Examiner
Art Unit: 1756

Continuation of 2. NOTE: The applicant proposes cancellation of claim 4 without changing the dependency of claims 5-7 and 12, which depend upon claim 4..

Continuation of 5. does NOT place the application in condition for allowance because: In response to the arguments of the applicant, the examiner notes that the issue of inherency is also well treated in patent case law. The examiner in particular points to the compound disclosed by Takasu et al. JP 59-177743 which uses the same phthalocyanine as that of the example 1 of the instant specification and Tatzono et al. JP 04-185485, which uses the same dye as example 2 of the instant specification.. The coverage which the applicant would be accorded for the media, would be irrespective of how the media were used and the applicant could sue persons making this medium for use with longer wavelength lasers. Phthalocyanines all absorb due to the Soret band at at least one wavelength within the 360-460 nm range, irrespective of where the absorption maxima may be. (molecular absorptions are quite wide, often 100 or more nm at half height. The examiner's position is supported by Iwamura et al. and Whalley. With respect to the presence of other dyes, the claims are open to these and clearly embrace them through the use of "Comprising" type language. There are no claims directed to the process of recording in the medium using 360-460 nm light. As discussed before the spot size is dependent upon both the wavelength and the NA. The assertion that no PC dyes are used in the recording or recording media is factually incorrect based upon the evidence on the record. Please review the specific sections cited in the office action. the rejections stand.

MA
12/14/01